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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
JIANG, SHAOJIA A	
ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/941,589	PICARD-LESBOUEYRIES ET AL.	
	Examiner	Art Unit	
	Shaojia A. Jiang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2 and 4-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is a response to Applicant's response filed November 30, 2004 wherein no claims have been amended; claim 30 is newly submitted.

Currently, claims 1-2 and 4-30 are pending in this application.

Claims 1-2 and 4-30 are currently under examination on the merits.

The terminal disclaimer filed on November 30, 2004, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. 6,733,765 has been reviewed and is accepted.

Therefore, the obviousness-type double patenting rejections of Claims 1-2 and 4-29 made under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,733,765, of record stated in the Office Action dated July 1, 2004 is withdrawn.

Applicant's declaration of Carole Guiramand (not inventor) submitted November 30, 2004 under 37 CFR 1.132, is acknowledged and will be further discussed below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2 and 4-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahms et al. (5,911,981, of record) and Erillli et al. (5,629,279, of record) and Ribier et al. (5,601,833 of record) for the same reasons of record stated in the Office Action dated July 1, 2004.

Dahms et al. discloses a stable **foaming** composition in an aqueous medium containing water at least 10% by weight (for example, see col.12 line 65 to col.13 line 10, the table therein) comprising a surfactant system generating a large volume of a stable foam therein containing paracrystallin phase or lamellar phase (see col.11 lines 3-24; col.12 line 65 to col.13 line 10, the table therein) such as direct hexagonal phase (Fig.2, 7, 9-10 and col.3 lines 61 to col.4 line 30), water-soluble soaps for cleaning skin or hair including removing a greasy soil from skin or hair such as shampoo or shower gel (see also abstract, col.1 lines 5-16, col.2 lines 8-34, fig. 2, col.3 lines 6-13 and 63-66, col.10 lines 34-35, 45, 54-55, col.13 lines 35-36 and Table 1-5 at col.11-15). Dahms et al. also teaches that one of the applications of the composition therein is shaving creams (see col.2 lines 24-6 and col.4 lines 37-38). Dahms et al. further discloses that the surfactant system comprises one water-insoluble surfactant in about 75% weight (nonionic or amphoteric) and water soluble anionic surfactants, C8-C12 acyl lactylate (0.1-25% weight) and a sulfated anionic surfactant (see the structural formula at col. 3 lines 40-49, col.4 line 64, col.8 lines 55-60, and claims 1-16).

Erillli et al. discloses a stable **foaming** composition in an aqueous medium for cleaning skin comprising a surfactant system which comprises water-insoluble

surfactants (nonionic or amphoteric) and water soluble surfactants (10-30% or 1-10% weight) within the instant claims. Erillli et al. also discloses that the active agents therein range from 0.5% to 5%. See abstract, col.2-8 and claims 1-9.

The prior art does not expressly disclose that the employment of an active agent here in combination with a surfactant system herein in a composition and a method for cleaning greasy skin and or acne skin. The prior art does also not expressly disclose the particular range of amounts of surfactants herein in the composition. The prior art does also not expressly disclose that the surfactant system is stable at up to 45^0C and the modulus recited in claim 30. However, the stability and modulus of the composition are deemed to the inherent properties of the composition.

Ribier et al. discloses that a composition for the simultaneous treatment of skin such as protecting and nourishing including removing fatty substance in the skin comprises water-soluble surfactants, water-insoluble surfactants, and active agents such as anti-oxygenated-free-radical agents and vitamins. See abstract, col.1 line22, col3 lines 50-51, col.4 lines 10-22, col.7 and claims 1-17.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ a surfactant system herein in combination with an active agent here in a composition and a method for cleaning greasy skin and/or acne skin, and to optimize the surfactant system to be stable at up to 45^0C, and to optimize the particular range of amounts of surfactants herein in the composition.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ a surfactant system herein in combination with an active

agent here in a composition and a method for cleaning greasy skin and or acne skin since adding active agents herein such as salicylic acid to a foaming composition for cleaning skin is well known in the art. Moreover, the surfactant systems in the compositions of Dahms and Erillli are known to be useful in cleaning greasy skin. Therefore, one of ordinary skill in the art would have reasonably expected that combining the surfactant system of Dahms or Erillli and an active agent known useful for the same purpose (i.e., cleaning or treating skin) in a composition to be administered would improve the therapeutic effect for cleaning/treating skin. Further, the teachings of Ribier et al. provide the motivation for the combination herein.

Additionally, although the prior art does not expressly teach that the surfactant system would be stable at up to 45^0C, a skilled artisan would clearly recognize that the thermal stability and modulus of the composition are merely inherent properties of the composition therein. Since it is well settled that recitation of an inherent property of a composition will not further limit claims drawn to a composition.

Moreover, one of ordinary skill in the art would have been motivated to optimize the surfactant system to be stable at up to 45^0C, and to optimize the particular range of amounts of surfactants herein in the composition because it is within the skill in the art to select optimal parameters, optimizing amounts of ingredients and measuring their inherent properties, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Thus the claimed invention as a whole is clearly prima facie obvious over the combined teachings of the prior art.

Response to Argument

Applicant's arguments and the declaration of Dr. Freedolph D. Anderson submitted April 17, 2003 in Paper No. 16 under 37 CFR 1.132 filed November 17, 2003 with respect to this rejection made under 35 U.S.C. 103(a) of record in the previous Office Action July 1, 2004 have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art as further discussed below.

Applicant primarily argues the difference between the claimed invention and the cream composition of Dahms by presenting the summarized result in the table at page 9. Applicant's argument is not found convincing. Dahms et al. clearly discloses the composition having stable **foaming** properties as the instantly claimed and comprising the same or substantial similar surfactant system comprises a surfactant system generating a large volume of a stable foam therein containing paracrystallin phase or lamellar phase such as direct hexagonal phase, one water-insoluble surfactant in about 75% weight (nonionic or amphoteric) and water soluble anionic surfactants, acyl lactylate (0.1-25% weight) and a sulfated anionic surfactant. Dahms et al. also teaches that one of the applications of the composition therein is shaving creams.

It is noted that the instant claim is also drawn to a foaming composition for treating greasy skin. Regarding the recitation "paracrystalline phase", the attention is directed to Applicant's own definition in the specification herein (see page 6 line 6-7 of the specification herein) "the paracrystalline phase formed (or **liquid crystal**).." (emphasis added), and "one paracyrstalline phase of direct hexagonal or cubic type

appears.." (see page 6 line 1-2 of the specification herein), "the terms "**lamellar phase**", "direct hexagonal phase", and "cubic phase" have the meanings usually given to them by those skilled in the art" (emphasis added, see page 7 line 10-12 of the specification herein). Thus, the instant paracrystalline phase clearly reads on the liquid crystalline structures such as such as direct hexagonal phase and the instant paracrystalline phase itself differs not from the liquid crystalline structures disclosed by Dahms et al.

In particular, Dahms et al. discloses an aqueous medium containing water at least 10% by weight in the stable foaming composition therein (see col.12 line 65 to col.13 line 10, the table therein).

More importantly, the table is not seen to provide any comparative examples with the compositions of Dahms but merely comparing with Applicant's own examples.

The reference of Cook provided by Applicant clearly teaches that "Foams are created by dispersing air or a gas in a surfactant containing liquid" and "gas bubbles dispersed in a liquid are stabilized in the same was as emulsion, i.e., by formation of surfactant layers at the gas-liquid interface" (see the last paragraph of page 1 to 1st paragraph of page 2) and also teaches various foam structures including hexagonal foams (see Fig 2 and 4). Thus, a foaming composition is known to generate gas bubbles. The instant paracyrstalline phase of direct hexagonal is also generated by formation of surfactant layers at the gas-liquid interface according to the specification herein. Hence, the instant paracyrstalline phase of direct hexagonal type itself is not different from those liquid crystalline structures disclosed by Dahms et al. and Cook,

and have the meanings usually given to them by those skilled in the art as Applicant admits in the specification.

Applicant again further argues that Erillli and Ribier do not compensate for Dahms' deficiencies. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 SPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See MPEP 2145. In the instant case, Erillli and Ribier have been cited by the examiner primarily for its teaching that water-insoluble surfactants (nonionic or amphoteric) and water soluble surfactants (10-30% or 1-10% weight) within the instant claims and the active agents therein range from 0.5% to 5%, such as anti-oxygenated-free-radical agents and vitamins, are known in the art.

Additionally, although the prior art does not expressly teach that the surfactant system would be stable at up to 45^{0}C and the and modulus, a skilled artisan would clearly recognize that the thermal stability and modulus are merely an inherent properties of the composition therein since Dahms et al. discloses a stable foaming composition in an aqueous medium. It is well settled that recitation of an inherent property of a composition will not further limit claims drawn to a composition.

Moreover, one of ordinary skill in the art would have been motivated to optimize the surfactant system to be stable at up to 45^{0}C, and to optimize the particular range of amounts of surfactants herein in the composition because it is within the skill in the art to select optimal parameters, optimizing amounts of ingredients and measuring their

inherent properties, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

The declaration with the Exhibit submitted November 30, 2004 under 37 CFR 1.132, has been fully considered but is ineffective to overcome the 103(a) rejections herein as to nonobviousness or unexpected results. First, it is unclear as to why Applicant provides the comparison between the present invention an the Example 2 of US 6,362,146. Second, no side-by-side comparison with Dahms, i.e., providing comparative figures at 45^0C of lamellar phase, as same as Dahms' Figures in the patent, is in the declaration in support of nonobviousness for the instant claimed invention over the prior art.

Therefore, the declaration is ineffective and insufficient to rebut the prima facie case herein.

Furthermore, as discussed in the previous Office Action, Applicant's data shown in the Examples 1-2 of the specification at pages 26-33 herein have been fully considered with respect to the nonobviousness and/or unexpected results of the claimed invention over the prior art but are not deemed persuasive for the reasons below. Examples herein provide no clear and convincing evidence of nonobviousness or unexpected results over the cited prior art since there is no comparison to the same present. Moreover, Examples herein merely demonstrate two particular compositions within the instant claims. Thus, the evidence in the examples is also not commensurate in scope with the claimed invention and does not demonstrate criticality of a claimed range of the ingredients in the claimed compositions. See MPEP § 716.02(d).

Therefore, the evidence presented in specification herein is also not seen to support the nonobviousness of the instant claimed invention over the prior art.

Therefore, motivation to combine the teachings of the prior art cited herein to make the present invention is seen. The claimed invention is clearly obvious in view of the prior art.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

Applicant's remarks and the Office Action with respect to the co-pending application 10/245,569 are acknowledged.

In view of the rejections to the pending claims set forth above, no claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Anna Jiang, Ph.D.
Primary Examiner
Art Unit 1617
February 9, 2005